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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/760,897      | 01/17/2001  | John J. Harrington   | 0221-00030(C)       | 3522             |

7590 05/19/2003

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EXAMINER

FORMAN, BETTY J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/760,897

Applicant(s)

HARRINGTON ET AL.

Examiner

BJ Forman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 58-77 is/are pending in the application.
- 4a) Of the above claim(s) 58-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 02/03.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**FINAL ACTION**

A. This action is in response to papers filed 19 December 2002 and 14 February 2003 in which the specification was amended to insert missing pages 54 and 54 and to cross-reference parent applications 09/515,124 and 09/276,820.

Applicant requests that the specification be amended to add missing pages 53-54. In a telephonic interview between Applicant's representative (Mr. Contera) and the examiner the Amendments of 12-19-02 were discussed. During the interview, Mr. Contera explained in detail how and why the missing pages do not constitute new matter. Details of the interview are presented in the Interview Summary of 12 February 2003 and the papers filed 14 February 2003. The examiner agreed with Mr. Contera's assessment of the missing pages and stated that pages 53-54 would be entered.

Applicant further requests that the specification be amended to incorporate by reference parent applications 09/276,820 and 09/515,124 as originally requested in papers filed 27-03-01. In view of Applicant's remarks and in view of the last paragraph of the originally filed specification wherein all cited references are incorporated by reference, the amendments filed 27-03-01 incorporating the parent applications by reference are entered.

B. This action is further in response to papers filed 26 June 2001 in which Claim 30 was canceled and new Claims 58-77 were added. These papers were non-responsive to the Office Action of 25 June 2001. The amendments were entered.

C. This action is further in response to papers filed 20 December 2001 in which the Abstract was amended to contain 150 words or less; Claims 63, 65, 68, 72-74 and 76-77 were amended; and a Response to the Office Action of 25 June 2001 was submitted. The amendments have been thoroughly reviewed and entered. The previous rejection of Claim 30 is withdrawn in view of the cancellation of Claim 30. New Claims 58-77 are addressed below.

### **Restrictions**

D. Newly submitted claims 58-77 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Previously rejected Claim 30 was drawn to a primer molecule comprising a PCR amplifiable sequence and a degenerate 3' terminus. The newly submitted claims are drawn to methods for expressing a protein and a cell expressing a protein. The Inventions of Claim 30 and newly submitted Claims 58-77 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different functions i.e. the invention of Claim 30 functions as a primer; the invention of Claims 58-71 and 75 function to produce a protein; and the invention of Claims 72-74 and 76-77 function as a protein expressing cell. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

Accordingly, claims 58-77 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### **Status of the Claims**

E. Claims 1-57 are canceled.

Claims 58-77 are withdrawn from consideration.

**F. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


### Conclusion


G. No claim is allowed.

H. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (703) 306-5878. The examiner can normally be reached on 6:30 TO 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-8724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
BJ Forman, Ph.D.  
Patent Examiner  
Art Unit: 1634  
May 9, 2003

  
GARY BENZION, PH.D.  
SUPERVISORY PATENT EXAMINER  
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